

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q91743

Akihiro GOTO, et al.

Appln. No.: 10/558,384

Group Art Unit: 1792

Confirmation No.: 4167

Examiner: Homing, Joel G.

Filed: September 5, 2006

For: ELECTRODE FOR DISCHARGE SURFACE TREATMENT, MANUFACTURING
METHOD FOR ELECTRODE FOR DISCHARGE SURFACE TREATMENT,
DISCHARGE SURFACE TREATMENT APPARATUS, AND DISCHARGE SURFACE
TREATMENT METHOD

RESPONSE TO ELECTION OF SPECIES

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This responds to the Election of Species Requirement, dated November 4, 2009.

Previously, in response to the July 29, 2009 Restriction/Election of Species Requirement, Applicant elected claims 90-115 for examination. The Examiner believes claims 60, 62-64, 66, 67, 69, 71-74, 76-80, 82-87, 89-103, 105-111, 113-129, 131-138 and 140-143 are generic.

In the present Requirement, the Examiner acknowledges Applicant's election of claims 90-115, but requests that the Applicant elect a *specific composition of the electrode material*. The remainder of the Requirement, i.e., items 2-4, is merely a reiteration of the July 29, 2009 Restriction/Election of Species Requirement.

On November 5, 2009, the undersigned contacted the Examiner and the Examiner's Supervisor for clarification. The Examiner indicated that although none of the claims recite a specific material per se, it is requested that the Applicant elect one material from, for example, the tables on pages 22 and 27 of the present Application (i.e., Table 1 and Table 2).

In view of the above, Applicant elects the material "stellite 2 fine powder" from Table 1 on page 22 of the present Application. Applicant submits that all of the previously elected claims 90-115 read on the elected species, where claims 90-103, 105-111 and 113-115 (out of the elected set of claims 90-115) are currently considered generic by the Examiner.

Applicant submits that the above election is made with traverse. As an initial matter, the criteria for election should be based on presentation of CLAIMS directed to more than one species. However, none of the elected claims recite or are limited to any of the *specific* materials listed in Table 1 and Table 2 of the present Application, where the Examiner has requested the Applicant to elect a single material from one of the tables. The claimed invention is applicable to a wide variety of materials. Thus, the present election of species requirement and subsequent election is deemed arbitrary at this time and Applicant's selection is made merely to further prosecution.

Furthermore, in the November 12, 2009 Interview Summary, the Examiner notes that a search and examination burden exists. However, during the November 5, 2009 telephone discussions, both the Examiner and the Examiner's Supervisor indicated that during examination, the search would not be limited to any specific material elected by the Applicant

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since the independent claims are not so narrowed. Thus, the Examiner already conceded that a full search is necessary regardless of Applicant's election. Accordingly, the Examiner's assertion that a search and examination burden exists is deemed premature and without merit *at this time in prosecution*.

Applicant submits that if any of the elected claims is found to be allowable, claims dependent therefrom should similarly be considered allowable in the same application.

Applicant reserves the right to file a Divisional Application directed to any non-elected claims.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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